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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,291	04/05/2006	Edward J. Cheal	OLK-002.01	6942
25181	7590	10/31/2008		
FOLEY HOAG, LLP PATENT GROUP, WORLD TRADE CENTER WEST 155 SEAPORT BLVD BOSTON, MA 02110			EXAMINER SCHILLINGER, ANN M	
			ART UNIT	PAPER NUMBER
			3774	
			MAIL DATE	DELIVERY MODE
			10/31/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,291

Applicant(s)

CHEAL ET AL.

Examiner

ANN SCHILLINGER

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 11, and 12-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11, 12, and 14-16 of U.S. Patent No. 7,044,975 in view of Henssge et al. (U.S. Pat. No. 5,047,060). US Pat. No. 7,044,975 does not disclose a shaft with a tapered mid-section and a distal end with a rounded tip. However, Henssge et al. teaches a hip joint prosthesis with these features as shown in Figures 1-3 and columns 1 and 2. It is well-known in the art to use this type of shape for a joint prosthetic shaft as it better fits the natural bone's anatomy and requires less bone to be removed from the patient to implant the prosthesis. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a shaft with a tapered mid-section and a

distal end with a rounded tip in order to it better fit the natural bone's anatomy and remove less bone from the patient to implant the prosthesis.

Claims 1, and 11-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3 and 10, and 4, respectively, of copending Application No. 10/605322 (US Pub. No. 2004/0107001). Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed towards a joint prosthesis using a spigot and a key to hold parts of the prosthesis together.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 8, 23, 24, and 26-28 are rejected under rejected under 35 U.S.C. 102(b) as being anticipated by Schelhas et al. (US Pat. No. 5,032,130). Schelhas et al. discloses the following of the claimed invention: a head member (1), with a bore (Figure 1); a proximal body (2), with a base (5A), a plug (5B), and a spigot (5) with a cylindrical locking band (4) with a constant cross-sectional geometry along its length; a stem member (12, 20) with a proximal portion (20) having a stem bore with a cylindrical receiving portion with a constant cross-sectional geometry along its length (22) that may receive the spigot by a friction-tight press-fit

(col. 2, line 55 through col. 3, line 4); and a shaft (12) with a continuously tapered midshaft portion and distal portion that has a rounded tip (Figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schelhas et al. in view of Keller (US Pat. No. 4, 908,032). Schelhas et al. teaches the invention substantially as claimed, however, Schelhas et al. does not teach the use of a second locking band. Keller teaches a hip joint replacement prosthesis that uses two locking bands in col. 2, lines 38-62 for the purpose of more securely locking the proximal body and the stem member together. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Schelhas et al. by added an additional locking band in order to more securely affix the proximal body to the stem member.

Claims 9, 10, 25, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schelhas et al. in view of Morrey et al. (US Pat. No. 4,608,055) or Schelhas et al. in view of Keller, further in view of Morrey et al. Schelhas et al., as modified by Keller, teaches the invention substantially as claimed, however, they do not teach the proximal portion of the stem member having a rectangular cross-section and being tapered in the medial-lateral and anterior-posterior directions. Morrey et al. teaches a hip prosthesis where the proximal portion of the stem member having a rectangular cross-section and being tapered in the medial-

lateral and anterior-posterior directions in Figures 1 and 5 and columns 5 and 6 for the purpose of retaining the prosthesis within the femur. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the stem member of Schelhas et al. by giving its stem member's proximal portion a rectangular cross-section and a tapering in the medial-lateral and anterior-posterior directions in order to better hold the prosthesis in its desired location.

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schelhas et al. in view of Lazzeri et al. (US Pat. No. 4,963,155). Schelhas et al. teaches the invention substantially as claimed, however, Schelhas et al. does not teach the use of a key with corresponding receptacles. Lazzeri et al. teaches a set of surgical products, including a hip prosthesis that use a key system col. 2, lines 1-20, column 3, and column 4 for the purpose of providing the prosthetic with the proper orientation required for a particular patient. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the key system of Lazzeri et al. on the device of Schelhas et al. in order to provide the prosthetic with the proper orientation required for a particular patient.

Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schelhas et al. in view of McTighe et al. (US Pat. No. 5,653,765). Schelhas et al. teaches the invention substantially as claimed, however, Schelhas et al. does not teach the use of a bolt with an additional receptacle at the base of the bore. McTighe et al. teaches a hip joint prosthesis that uses a bolt and receptacle in col. 3, line 51 through col. 4, line 29 for the purpose of securely locking the parts of the prosthesis together. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Schelhas et al.

by including the bolt and receptacle system of McTighe et al. in order to secure lock the proximal body to the stem.

Response to Arguments

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./
Examiner, Art Unit 3774

/William H. Matthews/
Primary Examiner, Art Unit 3774

